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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/762,008	01/21/2004	Dieter Grob	HORA.P0102US	4524

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EXAMINER

HOFFMAN, MARY C

ART UNIT	PAPER NUMBER
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3733

DATE MAILED: 08/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/762,008	GROB ET AL.	
	Examiner	Art Unit	
	Mary Hoffman	3733	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 June 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-6 and 8-53 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-6 and 8-53 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 January 2004 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

With regard to claims 38-53, these claims are not being interpreted under 112 6th paragraph, since Applicant has included detailed structure within “means-plus-function” recitation.

Claims 1-2, 4-6, 8-13, 15-22, 24-47 and 49-53 are rejected under 35 U.S.C. 102(b) as being anticipated by Sevrain et al. (U.S. Patent No. 5,707,373).

Sevrain et al. disclose an implant (FIG. 15) comprising a superior implant (FIG. 15, ref. #130) having an articulating surface (top surface) and a fixation surface (bottom surface) capable of secured placement on a resurfaced superior articulating facet of a selected cervical vertebra, and an inferior implant (FIG. 15, ref. #140) having an articulating surface (bottom surface) and a fixation surface (top surface) and capable of secured placement on a resurfaced inferior articulating facet of a cervical articulating immediately above the selected cervical articulating such that the articulating surface of the inferior implant interacts with the articulating surface of the superior implant. The superior implant and inferior implant are each generally disk-shaped. A tab (FIG. 15, ref. #138) extends from the generally disk-shaped portion of the superior implant. The tab is

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capable of attaching, or touching, to the lateral mass of the selected cervical vertebra.

The tab extends from the remainder of the superior implant to form an angle of between 110 and 160 degrees (see spikes, ref. #150, 152, 154 in FIG. 15, inside angle of spikes). The tab is capable of being attached to the lateral mass of the selected cervical vertebra with a screw; for example, the screw could be placed through the central hole in a similar way that the tool shown in FIG. 19 extends through the central hole. The inferior implant further comprises a tab (FIG. 19, ref. #150, 152, 154) extending from the generally disk-shaped portion of the inferior implant that forms an angle (see acute angle [front-view] formed by spikes ref. #150, 152, 154 in FIG. 19). The cervical facet resurfacing implant is capable of attaching to the inferior articular process of the cervical vertebra immediately above the selected cervical vertebra. The tab is capable of being attached to the inferior articulating process of the cervical vertebra immediately above the selected cervical vertebra with a screw. At least one of the superior implant and the inferior implant comprises a surface fixation mechanism (FIG. 16, ref. #144 and 148). The surface fixation mechanism comprises a screw hole (FIG. 16, see threaded hole, ref. #148). The surface fixation mechanism comprises multiple regions and wherein each of the regions has at least one ridge oriented in a different direction than the other regions (FIG. 16, inside and outside threading, ref. #148 and 144). The articulating surface of at least one of the inferior implant and the superior implant is composed of any known biomaterial, which includes cobalt-chromium alloy, ceramic, UHMWPE, pyrolytic carbon, and Ti/AlN (col. 8, lines 60-end). The cervical facet resurfacing implant further comprising a trans-lateral mass fixation mechanism capable of securing the

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inferior implant to the inferior articular facet, such as a screw (FIG. 16, ref. #144). The implant comes in various sizes, including a range of 1 to 6mm thick, or 3 to 14mm in diameter (col. 9, line 3).

With regard to the statements of intended use and other functional statements, they do not impose any structural limitations on the claims distinguishable over Sevrain et al., which is capable of being used as claimed if one so desires to do so. *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Furthermore, the law of anticipation does not require that the reference "teach" what the subject patent teaches, but rather it is only necessary that the claims under attack "read on" something in the reference. *Kalman v. Kimberly Clark Corp.*, 218 USPQ 781 (CCPA 1983). Furthermore, the manner in which a device is intended to be employed does not differentiate the claimed apparatus from prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987). While the device of Sevrain et al. is not intended to be used in the cervical facet, it is of the appropriate size and shape to fit into this small space and is capable of "secured placement" and being "attached" to this anatomical space, unlike the references cited in the previous office action as shown in Applicant's argument as supported by the declaration of John E. Sherman, M.D.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 14, 23 and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sevrain et al. (U.S. Patent No. 5,707,373) in view of Fitz (U.S. Patent No. 5,571,191).

Sevrain et al. disclose the claimed invention except for the fixation surface of at least one of the inferior implant and the superior implant having at least one of: a porous coating, a porous onlay material, a biologic coating, a surface treatment, and a material facilitating ingrowth of bone.

Fitz discloses using a porous coating to allow for bony ingrowth to occur and firmly attach implant components to the bone (col. 3, lines 35-40).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to construct the device of Sevrain et al. with a porous coating in view of Fitz in order to allow for bony ingrowth to occur and firmly attach implant components to the bone.

Response to Arguments

Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Note: Applicant is reminded that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the

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prior art structure is capable of performing the intended use, then it meets the claim.

The examiner notes that the claims as written contain mainly functional language, and while the device of Sevrain et al. is not intended to be used in the cervical vertebra or even the vertebra in general, it is the examiner's opinion that the cranial fixation flap of Sevrain et al. meets the current functional limitations.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Please see attached PTO-892.

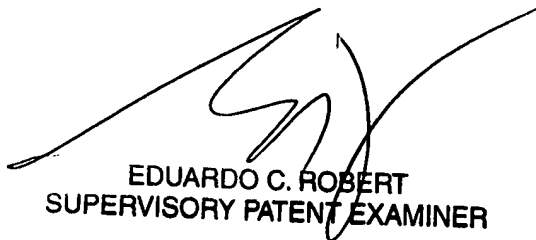
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mary Hoffman whose telephone number is 571-272-5566. The examiner can normally be reached on Monday-Friday 9:00-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo C. Robert can be reached on 571-272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MCH



EDUARDO C. ROBERT
SUPERVISORY PATENT EXAMINER